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PATENT
Attorney Docket No. 101.0093-01000
Customer No. 22882

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Confirmation No.: 6670
Gary K. Michelson)
Serial No.: 10/675,820) Group Art Unit: 3775
Filed: September 30, 2003) Examiner: James L. Swiger III
For: DYNAMIC GUARD)

Mail Stop APPEAL BRIEF
Commissioner for Patents
P.O. Box 1450
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Sir:

REPLY BRIEF

Appellant submits the following reply to the Examiner's Answer dated April 30, 2009 ("Answer").

I. Introduction

In the Answer, the Examiner responds to the Appeal Brief, but does not rebut the arguments presented by Appellant. The claim rejections and response to argument section of the Answer appear to be verbatim reproductions from the Final Action of July 25, 2008 ("Final Action"). Therefore, rather than merely repeating arguments from the Appeal Brief countering the Examiner's arguments from the Final Action, additional argumentation clarifying and supplementing Appellant's positions is provided herein. Appellant addresses the Examiner's Answer by indicating the section/sub-section numbering utilized in the Appeal Brief.

II. Argument

Section I of the Appeal Brief:

The present invention as claimed in claims 1-28 (including independent claim 1) is patentable over the Examiner's rejection under 35 U.S.C. § 103(a) based on the combination of U.S. Patent Publication No. 2003/0135220 to Cauthen ("Cauthen") and U.S. Patent No. 5,846,249 to Thompson ("Thompson").

Reply Brief 6-30-09.doc

Part A of Section I

Thompson is non-analogous art to the claimed invention of independent claim 1.

According to the Federal Circuit:

The 'analogous art' test—has long been part of the primary Graham analysis articulated by the Supreme Court. See Dann, 425 U.S. at 227-29; Graham, 383 U.S. at 35. The analogous-art test requires that the Board show that a reference is either in the field of the applicant's endeavor or is reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection. In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992). References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. Id. ("It is necessary to consider the reality of the circumstances, in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor." (quoting In re Wood, 599 F.2d 1032, 1036 (C.C.P.A. 1979))).

(In re Kahn, 441 F.3d 977, 986-87 (Fed. Cir. 2006).)

Accordingly, the Federal Circuit indicates that to satisfy the analogous art test and rely on a reference under 35 U.S.C. § 103(a), a reference must be either (1) in the field of the applicant's endeavor or (2) reasonably pertinent to the problem with which the inventor was concerned. Thompson is directed to a video gynecological examination apparatus used in conjunction with conventional vaginal speculums for dilating a patient's vagina. In rejecting independent claim 1, the Examiner relies on one of the vaginal speculums of Thompson, specifically a speculum 103 having "joints 123" according to the Examiner. Since vaginal speculums are used for inter-vaginal observation (and obviously not spinal surgery), Appellant submits that vaginal speculums are clearly not within the field of Appellant's endeavor.

Accordingly, in order for the Examiner to rely on Thompson, the Examiner must show that a vaginal speculum is reasonably pertinent to creating a protected surgical pathway to a disc space. Such a showing must be accomplished without ignoring the reality of the circumstances. The reality is that a vaginal speculum is gently inserted into a patient's vagina to dilate the soft tissue thereof. Unlike a vaginal speculum, the

guard of independent claim 1 is used in human spinal surgery which requires contact with bone. Appellant submits that common sense dictates that one of ordinary skill would not reasonably be expected to look to vaginal speculums (such as the speculum 103 of Thompson) to solve this problem. Therefore, because Thompson is non-analogous art to the claimed invention, Appellant submits the obviousness rejection under 35 U.S.C. § 103(a) based on such a combination cannot be maintained.

Part B of Section I

Cauthen and Thompson teach away from one another.

"When the prior art teaches away from a combination, that combination is more likely to be nonobvious." (*In re Icon Health and Fitness, Inc.*, 496 F. 3d 1374, 1381 (Fed. Cir. 2007) citing *KSR v. Teleflex*, 127 S.Ct. at 1739-40.) Accordingly, references that teach away from the combination, and hence, the claimed invention can be determinative of a finding of nonobviousness.

Cauthen teaches two insertion instruments both labeled (10), and both including a hollow body (12). The first instrument (10) teaches a single handle (18) with a guide (20) extending therefrom pivotal about an articulating hinge (22) located on the exterior of the hollow body (12) adjacent the leading end of the insertion instrument (10). The second instrument (10) teaches having two such handles (18) and (37) with respective guides (20) and (35) pivotal about respective articulating hinges (22) and (36) located on opposite sides of hollow body (12).

Whether relying upon the first or second instruments (10), the pivot axes of the hinge (22) of Figs. 1 and 2 and the articulating hinges (22) and (36) of Figs. 13 and 14 are positioned adjacent the leading ends of the instrument (10), are disposed on the exterior of the hollow bodies (12), and are not offset from the hollow bodies (12). Contrary to Cauthen, Thompson teaches that the speculum 103 including the arms 123 (relied upon by the Examiner) forms a pivot axis that is positioned at the trailing end thereof and is located between an upper portion and a lower portion, where the upper and lower portions are offset from one another by the arms 123. Given these contrary

teachings, and the inherent difficulty in combining references having contrary teachings, Appellant submits that Cauthen and Thompson at the very least implicitly teach away from one another. Therefore, because Cauthen and Thompson teach away from one another, Applicant submits the obviousness rejection under 35 U.S.C. § 103(a) based on such a combination cannot be maintained.

Part C of Section I

The combination of Cauthen and Thompson is inoperable.

The Federal Circuit stated:

We have noted elsewhere, as a "useful general rule," that references that teach away cannot serve to create a prima facie case of obviousness. In re Gurley, 27 F. 3d 551, 553, 31 U.S.P.Q.2D (BNA) 1130, 1132 (Fed. Cir. 1994). If references taken in combination would produce a "seemingly inoperative device," we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness.

(McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1354 (Fed. Cir. 2001).) As shown in Fig. 3 of Thompson, the pivot axis of the speculum 103 is located between the upper portion and the lower portion thereof. However, if such a teaching were applied to Cauthen, Appellant submits that the resulting combination is inoperable. For example, if the instrument (10) of Fig. 2 of Cauthen were so modified, the hinge (22) (and its associated pivot axis) would be moved to a position in the passage of the hollow body (12). However, because of the new position of the hinge (22) in the passage, the operation of the instrument (10) would be prohibited. That is, the passage through the hollow body (12) would be interrupted, and therefore, instruments could not be inserted therethrough. Accordingly, Appellant submits that modifying Cauthen with the teachings of Thompson would produce a seemingly inoperable device. Therefore, because the combination of Cauthen and Thompson produces a seemingly inoperable device, Appellant submits the obviousness rejection under 35 U.S.C. § 103(a) based on such a combination cannot be maintained.

Because Thompson is non-analogous art to the claimed invention, Cauthen and Thompson teach away from one another, and the combination of Cauthen and

Thompson produces an inoperable result, the Examiner's rejection of independent claim 1 under 35 U.S.C. § 103(a) based on Cauthen and Thompson cannot be maintained. As such, Appellant submits that independent claim 1 is patentable over the Examiner's rejection under 35 U.S.C. § 103(a), and that dependent claims 2-28 are patentable at least due to their dependency from an allowable independent claim.

Section II of the Appeal Brief:

The present invention as claimed in claim 29 is patentable over the Examiner's rejection under 35 U.S.C. § 103(a) based on the combination of Cauthen, Thompson, and U.S. Patent Publication No. 2003/0023209 to Gruskin et al.

Appellant submits that, because independent claim 1 is allowable, the rejection of claim 29 under 35 U.S.C. § 103(a) is moot. Dependent claim 29, dependent from claims depending from independent claim 1, is patentable at least due to its dependency from an allowable independent claim.

Section III of the Appeal Brief:

The present invention as claimed in claim 30 is patentable over the Examiner's rejection under 35 U.S.C. § 103(a) based on the combination of Cauthen, Thompson, and U.S. Patent Publication No. 2003/0229401 to Mansouri et al.

Appellant submits that, because independent claim 1 is allowable, the rejection of claim 30 under 35 U.S.C. § 103(a) is moot. Dependent claim 30, dependent from claims depending from independent claim 1, is patentable at least due to its dependency from an allowable independent claim.

III. Conclusion

Appellant submits that independent claim 1 is patentable and that dependent claims 2-30, dependent from independent claim 1, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim. Therefore, Appellant respectfully requests the Board to reverse the Examiner's rejections, and allow claims 1-30.


If there are any fees due under 37 C.F.R. § 1.16 or 1.17 which are not enclosed herewith please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

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